48. (cancel d)

55. (currently amended) The method of claim 57, further including disposing said [cotaing] coating proximate a see-through surface.

REMARKS

In the final Office Action mailed 22 May 2003, claims 1-48, and 55-63 were examined. Claims 1-22 stood allowed and a restriction requirement was imposed upon claims 36-46 and 48. Claims 23, 25-35 47, and 55-63 were rejected under 35 USC § 102 as being anticipated by Hill U.S. Patent No. 4,673,609. However no citation of Hill '609 against claim 32 was in fact given, and applicant requests that the finality of the office action at least as to claim 32 and claim 60 be withdrawn. Applicant notes with appreciation that claim 24 was found to present patentable subject matter and would be allowable if rewritten to include the limitation of the parent claim. Claims 1-22 stand allowed.

In the within Amendment, in response to the restriction requirement applicant has canceled without prejudice or disclaimer non-elected claims 36-46 and 48. Applicant has amended claims 23, 28, 35, and 55. Applicant has not amended claim 32 or claim 60 because the basis of the Examiner's rejection of these claim as being anticipated by Hill '609 is not to be found in the final Office Action or in the predecessor office actions referenced by the pending final Office Action.

Claims 1-35, 47 and 55-63 are pending, wherein claims 1-22 stand allowed and wherein claim 24 has been found to present patentable subject matter.

CLAIMS 23, 25-35, 47, and 55-63 ARE NOT ANTICIPATED BY HILL '609

Amended claim 23 explicitly recites that at method step (d), modification of a portion of the first coating that is over-coated by the second coating so as to alter a characteristic of the first coating occurs "during formation of said pattern".

As understood by applicants, the Examiner's rejection of unamended claim 23 as being anticipated by Hill '609 was directed to such changes as Hill's coatings might undergo due to the "external environment taught by Hill (see col. 15, lines 44-68 . . .)". Even if

it is assumed that ambient lighting conditions might alt r Hill's coatings, it is apparent that such alterations occur after the Hill device and coatings hav be n manufactured. By contrast, amended claim 28 explicitly states that step (d) is directed to first coating modification that occurs during (i.e., not after) formation of applicant's pattern. Claim 55, which ultimately depends from claim 23, is amended to correct a typographical error.

Applicant submits that amended claim 28 includes at least one step not found in Hill. Thus, neither amended independent claim 28, nor claims 29-31, 47 and 56-59, which depend from claim 28, are anticipated by Hill.

Amended claim 28 recites at method step (c) that the first coating that is being applied has "a first coating portion whose shape is modifiable by energy applied during said method of forming", and that after completion of step (d), "said first coating portion is modified during said forming a laminate pattern of coatings".

The above language follows the subject matter of allowable claim 24, and further distinguishes from Hill and such effects as ambient environmental conditions might have upon portions of Hill's product after the fact.

As to claim 32, applicant cannot find a 35 USC § 102 rejection against claim 32 premised upon Hill, and as such has no guidance from the Examiner as to which portions of claim 32 are believed to be anticipated by Hill. Paragraph 4 in the pending final Office Action states in relevant part to claim 32 is anticipated by Hill "for the same reasons as given above and in paragraph 8 of the previous office action". But no reasons are "given above" and paragraph 8 of the previous office action (mailed 6 November 2002) simply says in relevant part that claim 32 is rejected as being anticipated by Hill "for the same reasons as given above and in paragraph 4 of the previous office action, no. 8, mailed 16 April 2002. But no reasons were "given above" and paragraph 4 of the 16 April 2002 Office Action does not even raise any rejection of claim 32 based upon Hill. (Claim 32 was rejected under paragraph 5 of the 16 April 2002 based upon 35 USC §103 based upon a combination of Yoshimura and Hill.) Further, the language at paragraph 4 of the 16 April 2002 Office Action references "paragraph 10 of the previous office action". But paragraph 10 of the previous Office

Action (mailed 1 June 2001) do s not make any 35 USC § 102 rejection of claim 32. Claim 35, which depends from claim 32, is amend d to correct a typographical error.

In short, applicants ask that the Examiner withdraw the finality of the pending Office Action against claim 32, or by way of Advisory Action advise as to which portions of pending claim 32 are believed anticipated by which portions of Hill under 35 USC § 102. Absent such guidance, applicants submit that claim 32 and dependent claims 33-35 are not shown to be anticipated by Hill.

Claim 60 is rejected as being anticipated by Hill '609 but applicant cannot find a 35 USC § 102 rejection against claim 60 premised upon Hill, and as such has no guidance from the Examiner as to which portions of claim 60 are believed to be anticipated by Hill. Paragraph 4 in the pending final Office Action states in relevant part to claim 60 is anticipated by Hill "for the same reasons as given above and in paragraph 8 of the previous office action". But no reasons are "given above" and paragraph 8 of the previous office action (mailed 6 November 2002) simply says in relevant part that claim 60 is rejected as being anticipated by Hill "for the same reasons as given above and in paragraph 4 of the previous office action, no. 8, mailed 16 April 2002. But no reasons were "given above" and paragraph 4 of the 16 April 2002 Office Action merely says in relevant part that claim 60 is rejected under 35 USC § 102 as being anticipated by Hill "for the same reasons as given above and in paragraph 10 of the previous office action". But paragraph 10 of the previous Office Action (mailed 1 June 2001) does not make any 35 USC § 102 rejection of claim 60, which claim came into existence after that Office Action.

In short, applicants ask that the Examiner withdraw the finality of the pending Office Action against claim 60, or by way of Advisory Action advise as to which portions of pending claim 60 are believed anticipated by which portions of Hill under 35 USC §102. Absent such guidance, applicants submit that claim 60 is not shown to be anticipated by Hill.

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CONCLUSION

This Amendment should be entered. Finality of the pending final Office Action should be withdrawn against claims 32 and 60 in that applicant finds no citation in the prosecution as to why these two independent claims are deemed anticipated by Hill.

Claims 1-22 stand allowed and claim 24 has been found to present patentable subject matter. Applicant submits that claims 23-48 and 55-63 are patentable over the references of record, and should be passed to allowance at this time.

A clean copy of claims pending after current amendment is appended hereto.

* * * * *

The Commissioner is authorized to charge any additional fees that may be required, including extension fees, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 468824-00003 [RI-69912/MAK]).

Respectfully submitted,
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